

<p>This Opinion is Not a Precedent of the TTAB</p>

Mailed: February 13, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Blueair AB

Serial No. 86112707

John R. Crossan of Crossan IP Law, LLC,
for Blueair AB.

Parker W. Howard, Trademark Examining Attorney, Law Office 117,
Hellen M. Bryan-Johnson, Managing Attorney.

Before Seeherman, Kuhlke and Lykos,
Administrative Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Blueair AB has appealed from the final refusal of the Trademark Examining Attorney to register BLUEWATER, in the stylized form shown below, for “tap-water purifying apparatus; water purifiers for household purposes; water purifying units, for potable water for household use,” in Class 11.¹

¹ Application Serial No. 86112707, filed November 7, 2013, pursuant to Section 1(b) of the Trademark Act (intent-to-use).



The mark is described as consisting “of a circular dot followed by the word BLUEWATER with initial capital letter and all in sans-serif typeface.” Color is not claimed as a feature of the mark.

Registration has been refused pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), in view of registrations owned by the same entity for the marks BLUE WATER TECHNOLOGIES in standard characters, with WATER TECHNOLOGIES disclaimed, for “water treatment and purification units for removal of phosphorus, arsenic, heavy metals and other contaminants from municipal wastewater, industrial process water, and drinking water”² and BLUE WATER TECHNOLOGIES and leaf design, as shown below, for “water treatment and purification units for denitrification and removal of phosphorus, arsenic, heavy metals and other contaminants from municipal wastewater, industrial process water, and drinking water.”³



This registration includes a claim of acquired distinctiveness under Section 2(f) as to the words BLUE WATER TECHNOLOGIES.

² Registration No. 3023179, issued December 6, 2005; Section 8 affidavit accepted; Section 15 affidavit acknowledged.

³ Registration No. 4281643, issued January 29, 2013.

It is the Examining Attorney's position that Applicant's mark so resembles the marks shown in the cited registrations that, if used on Applicant's identified goods, it is likely to cause confusion or mistake or to deceive.

We affirm the refusal to register.

Evidentiary Issue

Before proceeding to the merits of the refusal, we address an evidentiary matter. With its brief Applicant submitted, for the first time, a number of exhibits. The Examining Attorney has objected to this evidence, specifically Exhibits B through G, and Exhibit J, as untimely.⁴ The Examining Attorney's objections are well taken. Trademark Rule 2.142(d) provides that the record in the appeal should be complete

⁴ The Examining Attorney's objection has a typographical error. Instead of listing Exhibit "J" he repeated the letter "F": "Exhibit F (referred to by applicant as 'The Asserted BLUE WATER TECHNOLOGIES marks'), Exhibit G (referred to by applicant as 'Registrant's BLUE WATER TECHNOLOGIES systems'), and Exhibit F (referred to by applicant as 'Google.com search results for domestic or industrial systems')." 11 TTABVUE 16. It is clear that the second reference to "Exhibit F" was meant to be a reference to Exhibit J, since that exhibit indicates that it is the result of a "Google Search."

We also note that Applicant made reference to a Google search in its request for reconsideration, filed June 2, 2014, stating that it had attached as Exhibits A and B pages of current wagoogle.com [sic] results for searches on "water treatment." Although Applicant submitted two exhibits with the request for reconsideration, exhibits taken from wagoogle.com [sic] were not submitted. The Examining Attorney pointed this out in his denial of the request for reconsideration on June 23, 2014 ("Applicant claims that it has attached evidence supporting this assertion. However, no such evidence appears in the record. Because applicant failed to attach the evidence it cannot be considered, and applicant's unsupported argument is unavailing."). Applicant did not submit a request for remand to cure its apparent failure to include the referred-to evidence with its request for reconsideration. Applicant cannot overcome its failure by the untimely submission of the evidence with its appeal brief.

prior to the filing of an appeal. We give no consideration to the untimely submitted evidence.⁵

Likelihood of Confusion

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also, In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). *See also, In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

We turn first to the *du Pont* factor of the similarity or dissimilarity of the goods or services. Applicant's goods are identified as "tap-water purifying apparatus; water purifiers for household purposes; water purifying units, for potable water for household use." Such goods, as the identification makes clear, are for domestic use, and would be purchased by the general public for use in the home. The goods identified in the cited registrations are "water treatment and purification units for removal of phosphorus, arsenic, heavy metals and other contaminants from municipal wastewater, industrial process water, and drinking water" and "water

⁵ In view of the untimeliness of the evidentiary submissions we need not discuss the additional reasons given by the Examining Attorney for objecting to the exhibits, nor do we need to discuss the probative value of this evidence if it had been of record.

treatment and purification units for denitrification and removal of phosphorus, arsenic, heavy metals and other contaminants from municipal wastewater, industrial process water, and drinking water.” Based on the identifications, one purpose of these identified goods is to remove contaminants from municipal wastewater and industrial process water, and the purchasers and users of such goods would not be homeowners who would want water purifiers for household use. However, the identifications in the cited registrations also include water treatment and purification units for removal of contaminants from drinking water. These goods, as identified, would encompass the “tap-water purifying apparatus; water purifiers for household purposes; water purifying units, for potable water for household use” identified in Applicant’s identification.

We note Applicant’s argument that the registrant’s goods are different in nature from Applicant’s goods, and that the registrant’s goods are “huge, in-ground installations and/or trailer-size portable facilities” that would not be suitable for in-home or domestic use. Brief, 9 TTABVue 3. The problem with this argument is that we must determine the issue of likelihood of confusion on the basis of the goods as they are identified in the application and the cited registrations. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *CBS, Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983). As identified, the cited registrations would encompass drinking water purification units for household use.

Applicant also argues that the water its goods are designed to purify would not normally have the contaminants, i.e., phosphorus, arsenic, heavy metals, that the registrant's goods are designed to remove. However, the identifications in the cited registrations do not limit the water treatment and purification units to removal of those particular elements; rather, the identifications also include "other contaminants." This broad description would include the contaminants that Applicant's water purifiers would remove.⁶

Thus, we find that the goods are legally identical to the extent that the goods as identified in the cited registrations encompass the goods identified in Applicant's application. In view thereof, we need not rely on the Internet evidence submitted by the Examining Attorney of third parties that offer both water purification apparatus for household and for industrial use to show that these goods are related. Further, because the goods are legally identical, they must be deemed to travel in the same channels of trade. *In re Viterra*, 671 F.3d 1358, 101 USPQ2d 1905, 1908

⁶ We note that in its brief Applicant makes the statement, "If Registrant's claim for its goods under its asserted marks is considered by the Board to reach cleaning of pre-treated, household tap water, then that claim is too broad and should be restricted or stricken. Leave to convert this appeal then into a Cancellation Proceeding in part would then be appropriate." 9 TTABVUE 4. Once an application has been considered and decided on appeal it will not be reopened except for the entry of a disclaimer or upon order of the Director. See Trademark Rule 2.142(g). Thus, if Applicant is suggesting that if the Board should affirm the refusal of registration Applicant then be allowed to seek cancellation of the cited registrations, that would not be possible. Essentially, Applicant cannot wait to see what would happen in this appeal, and if the decision were adverse to Applicant, it would "convert" the appeal into a cancellation proceeding. If, during the course of examination, Applicant wanted to bring a cancellation action it could have done so, and requested that examination of the application be suspended. However, Applicant chose not to follow that course. Even now, during the pendency of the appeal, if Applicant had actually brought a cancellation action, it could have filed a request for suspension. However, the contingent suggestion in Applicant's brief to convert this appeal into a cancellation proceeding is not possible under the rules, and is denied.

(Fed. Cir. 2012) (when goods are identical, absent restrictions in the application and registration, goods are presumed to travel in same channels of trade to same class of purchasers). Thus, the second and third *du Pont* factors favor a finding of likelihood of confusion.

We next consider the *du Pont* factors of the similarity or dissimilarity of the marks and the strength of the cited registrations. In considering the similarity of the marks, we keep in mind that when marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992). *See also, In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257 (Fed. Cir. 2010).

We begin with a comparison of Applicant's mark and registrant's mark BLUE WATER TECHNOLOGIES in standard characters (Registration No. 3023179). We must consider the marks in their entirety as to appearance, sound, connotation, and commercial impression. *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005). Nevertheless, there is nothing improper in stating that more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entirety. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). Because the cited mark is in standard characters, it is not limited to any particular rendition of the mark, and therefore registrant may use the mark in any type font, including the upper and

lower type font used by Applicant. *See In re Mighty Leaf Tea*, 94 USPQ2d at 1260. Applicant's mark also includes a dot design, however, this design does not serve to distinguish the marks. In the case of a composite mark containing both words and a design, "the verbal portion of the mark is the one most likely to indicate the origin of the goods to which it is affixed." *In re Viterro Inc.*, 101 USPQ2d at 1908, quoting *CBS v. Morrow*, 218 USPQ at 200. Although this is not a hard and fast rule, we find that it is applicable here, since the dot is a common geometric feature that is not particularly prominent; it is by the word portion of the mark that consumers are likely to refer to and call for the goods. As for the fact that the cited mark contains the word TECHNOLOGIES and Applicant's mark does not, the presence or absence of this disclaimed word does not distinguish the marks. TECHNOLOGIES is a term that is highly suggestive or descriptive of goods of a technological nature. *See Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002) ("the disclaimed word 'Technologies' is highly suggestive or descriptive of the data processing and data transmission services in [applicant's] application"; "[applicant] selected the word 'Technologies' to describe or suggest the technological nature of its new services"). Nor does the presence or absence of a space between BLUE and WATER (BLUE WATER TECHNOLOGIES vs. BLUEWATER and design) distinguish the marks. Consumers will readily recognize the two words BLUE WATER in Applicant's mark, and view BLUEWATER as the equivalent of BLUE WATER. Thus, although we have compared the marks in their entireties, we think it appropriate to give greater weight to the words BLUE

WATER in both Applicant's application and the cited registration. We find that the marks are very similar in appearance, pronunciation, connotation and commercial impression.

We reach a similar result when we compare Applicant's mark with BLUE WATER TECHNOLOGIES and design (Registration No. 4281643). Both the plain block letters of BLUE WATER and the upper and lower sans serif font of BLUEWATER would appear to consumers to be simply two versions of the same mark. Although registrant's mark includes a leaf design, this does not serve to distinguish the marks; on the contrary, because the line emerging from the leaf separates the words BLUE WATER from TECHNOLOGIES, the similarity between this mark and Applicant's mark is emphasized.

Applicant has argued that the cited registrations are entitled to a narrow scope of protection, pointing out that the cited registrations issued over other BLUEWATER/BLUE WATER marks, and that third-party BLUE WATER registrations issued despite the presence of registrant's registrations. Applicant contends that its mark should be accorded similar treatment.

We need not engage in an extensive discussion of the third-party registrations, since the Board must assess each mark on the record of the particular application, and there is little persuasive value in third-party registrations showing what the Office has done in prior situations. *See In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001). There are differences in the meanings of the marks or in the goods/services between the third-party registrations and the cited

registrations that are not the case with Applicant's mark and the cited registrations, e.g., TRUE BLUE in the mark TRUE BLUE WATER SOLUTIONS (Registration No. 4066690) has a different meaning from BLUE WATER in BLUE WATER TECHNOLOGIES; and BLUE WATER RESOURCES (Registration No. 4461112) is for different services ("providing industrial water delivery services"). We also point out that at the time the cited registrations issued in 2004 and 2013, the third-party registration (No. 1815794) for SKY BLUE WATER, which issued in 1994, had been partially cancelled, so the goods in that registration were limited to "filtered bottled water."

Therefore, even if we accept that the cited registrations, because of the suggestive nature of the words BLUE WATER for purified water, have a limited scope of protection, that protection still extends to prevent the registration of BLUEWATER and dot design for legally identical goods.

The final *du Pont* factor discussed by Applicant is the lack of evidence of actual confusion. In its request for reconsideration Applicant argues that "it is now using its BLUEWATER and dot mark in the USA on its domestic, under-the-counter water purification systems, without protest from or conflict with the [cited] marks or its owner or, indeed, owners of the SKY BLUE WATER and TRUE BLUE WATER SOLUTIONS marks."

Applicant's uncorroborated statements of no known instances of actual confusion are of little evidentiary value. The lack of evidence of actual confusion carries little weight. *In re Majestic Distilling Co.*, 65 USPQ2d at 1205. This is particularly true

in this case, where Applicant has filed its application based on an intention to use the mark in commerce and we have no evidence about when Applicant began using its mark, or the extent of its use, such that we could ascertain whether there has been an opportunity for confusion to occur, if it were likely to occur.

These are the only *du Pont* factors that Applicant and the Examining Attorney have discussed, or for which evidence has been submitted. To the extent that any other factors are relevant, we treat them as neutral.

After reviewing all of the arguments and evidence, we find that Applicant's mark, used for its identified goods, is likely to cause confusion with the marks and goods identified in the cited registrations.

Decision: The refusal to register Applicant's mark BLUEWATER and design is affirmed.